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Appeal Brief

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of
Mittal et al.

Serial No.: 09/863,921

Group Art Unit: 3622

Filed: May 23, 2001

Examiner: Young, John L.

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Mohammad S. Rahman

For: PERSONALISATION OF PROMOTIONAL OFFERS

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APPELLANTS' APPEAL BRIEF

Sirs:

Appellant respectfully appeals the final rejection of claims 1 and 3-48 in the Office
Action dated July 13, 2005. A Notice of Appeal was timely filed on October 13, 2005.

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I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corp., Armonk, New York, assignee of 100% interest of the above-referenced patent application.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or Assignee which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1 and 3-48, all the claims pending in the application and set forth fully in the attached claims appendix (Section VIII), are under appeal. Claims 1-47 were originally filed in the application. Appellants filed an Amendent under 37 C.F.R. §1.111 on October 20, 2004 amending claims 1, 6, 22-28, and 35 and cancelling claim 2. Appellants filed an Amendent under 37 C.F.R. §1.111 on March 1, 2005 amending claims 1, 12, 15, 22-27, 29, and 41 and adding claim 48. Appellants filed an Amendment under 37 C.F.R. §1.116 on September 12, 2005 amending claims 6, 26, and 32.

Claims 1, 3-6, 15-32, and 42-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lerat (U.S. Publication No.2002/0010627) in view of DeLapa et al. (U.S. Patent No. 6,076,068), hereinafter referred to as "DeLapa". Claims 7-14 and 33-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lerat in view of DeLapa and

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Walker et al. (U.S. Patent No. 6,327,573), hereinafter referred to as "Walker". Appellants respectfully traverse these rejections based on the following discussion.

IV. STATUS OF AMENDMENTS

An after-final Office Action dated July 13, 2005 stated all the pending claims 1 and 3-48 were rejected. The Advisory Action of October 18, 2005 indicates that the Amendment filed under 37 C.F.R. §1.116 on September 12, 2005 amending claims 6, 26, and 32 would not be entered, and that for the purposes of appeal, the prior art rejections remain. The claims shown in the claims appendix (Section VIII) are shown in their amended form as of the March 1, 2005 Amendment.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The Appellants' claimed invention provides an apparatus, method, and computer program product (as generally described on pages 2-22 of the specification and generally shown in Figures 1-13) for conducting a promotional offer over a computer network. In one embodiment, the method comprises defining the structure of said promotional offer having a plurality of associated parameters, one or more of which are unspecified or variable (FIG. 1, step 110; page 5, lines 17-18 and 22 of the specification); targeting one or more of a plurality of customers as recipients of the promotional offer (FIG. 1, step 120; page 5, lines 19-20 of the specification); and distributing a record of the promotional offer to the customers over said computer network (page 5, line 20 of the specification); wherein one or more of the unspecified or variable

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parameters associated with the offer are individually assigned for one or more of the targeted customers to whom the record of the offer is distributed (FIG. 1, step 130; page 5, line 22 through page 6, line 2 of the specification), wherein said unspecified or variable parameters are defined when the promotional offer is accepted by respective customers (FIG. 4, steps 450 and 460; page 15, lines 19-20 of the specification), and wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined (page 13, lines 8-9 of the specification).

Another embodiment of conducting a promotional offer over a computer network comprises defining the structure of said promotional offer to be made to a plurality of customers having a plurality of associated parameters, one or more of which are unspecified or variable (FIG. 1, step 110; page 5, lines 17-18 and 22 of the specification), wherein one or more of the unspecified or variable parameters associated are able to be individually assigned for one or more of the targeted customers to whom a record of the promotional offer is distributed over said computer network (FIG. 1, step 130; page 5, line 22 through page 6, line 2 of the specification), wherein said unspecified or variable parameters are defined when the promotional offer is redeemed by respective customers (page 5, lines 22-24 of the specification), and wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined (page 13, lines 8-9 of the specification).

Another embodiment of conducting a promotional offer over a computer network comprises distributing to one or more targeted customers a record of said promotional offer having a plurality of associated parameters (page 3, lines 24-25; page 5, lines 22-24 of the

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specification); and defining values of one or more of the associated parameters for respective targeted customers (page 3, lines 1-15; page 5 lines 16-19 of the specification), when requested by the respective customers, wherein said one or more of the parameters associated with the promotional offer are individually assigned to one or more of the targeted customers (page 2, lines 3-5; page 5, lines 31-32 of the specification), wherein said one or more of the parameters are defined when requested by respective customers (page 13, lines 16-18 of the specification), and wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined (page 13, lines 8-9 of the specification).

Another embodiment of conducting a promotional offer over a computer network comprises targeting one or more of a plurality of customers as recipients of a said promotional offer having a plurality of associated parameters (FIG. 1, step 120; page 5, lines 19-20 of the specification), one or more of which are unspecified or variable (FIG. 1, step 110; page 5, lines 17-18 and 22 of the specification), wherein one or more of the unspecified or variable parameters associated with the promotional offer are individually assigned for one or more of the targeted customers to whom a record of time offer is distributed over said computer network (FIG. 1, step 130; page 5, line 22 through page 6, line 2 of the specification), wherein said unspecified or variable parameters are defined when the promotional offer is redeemed by respective customers (page 5, lines 22-24 of the specification), and wherein said promotional offer comprises a declinable value once said unspecified or variable parameters are defined (page 13, lines 8-9 of the specification).

Another embodiment of conducting a promotional offer over a computer network

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comprises distributing to one or more targeted customers a record of a promotional offer having a plurality of associated parameters (page 3, lines 24-25; page 5, lines 22-24 of the specification), wherein one or more of the associated parameters associated with the promotional offer have been individually assigned to one or more of the targeted customers (page 2, lines 3-5; page 5, lines 31-32 of the specification), wherein said parameters are defined when the promotional offer is redeemed by respective customers (page 5, lines 22-24 of the specification), and wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined (page 13, lines 8-9 of the specification).

Another embodiment comprises a computer program product having a computer readable medium having a computer program recorded therein (FIG. 13; page 20, lines 4-11 of the specification) conducting a promotional offer, said computer program comprising code adapted to defining the structure of said promotional offer having a plurality of associated parameters, one or more of which are unspecified or variable (FIG. 1, step 110; page 5, lines 17-18 and 22 of the specification), wherein said code targets one or more of a plurality of customers as recipients of the promotional offer (FIG. 1, step 120; page 5, lines 19-20 of the specification), wherein said code adapted to distributing a record of the promotional offer to the customers over said computer network (page 5, line 20 of the specification), wherein one or more of the unspecified or variable parameters associated with the promotional offer are individually assigned for one or more of the targeted customers to whom the record of the promotional offer is distributed (page 2, lines 3-5; page 5, lines 31-32 of the specification), wherein said unspecified or variable parameters are defined when the promotional offer is accepted by respective customers (FIG. 4,

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steps 450 and 460; page 15, lines 19-20 of the specification), and wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined (page 13, lines 8-9 of the specification).

Another embodiment for conducting a promotional offer comprises an apparatus (FIG. 13; page 20, lines 4-11 of the specification) comprising code adapted to define the structure of said promotional offer having a plurality of associated parameters, one or more of which are unspecified or variable (FIG. 1, step 110; page 5, lines 17-18 and 22 of the specification), wherein said code targets one or more of a plurality of customers as recipients of the promotional offer (FIG. 1, step 120; page 5, lines 19-20 of the specification), wherein said code adapted to distributing a record of the promotional offer to the customers over said computer network (page 5, line 20 of the specification), wherein one or more of the unspecified or variable parameters associated with the promotional offer are individually assigned for one or more of the targeted customers to whom the record of the promotional offer is distributed (page 2, lines 3-5; page 5, lines 31-32 of the specification), wherein said unspecified or variable parameters are defined when the promotional offer is accepted by respective customers (FIG. 4, steps 450 and 460; page 15, lines 19-20 of the specification), and wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined (page 13, lines 8-9 of the specification).

According to the embodiments of the invention, one or more of the unspecified or variable offer parameters are assigned default values (page 13, lines 20-26 of the specification). Furthermore, the assigned default values can be changed a predetermined number of times (page

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13, lines 26-27 of the specification). Moreover, the unspecified or variable parameters vary with time (page 5, lines 17-19 and page 5, line 31 through page 6, line 2 and page 6, lines 28-30 of the specification). Additionally, the unspecified or variable offer parameters comprises at least one of an offer discount information (page 2, lines 19-20; page 6, lines 29-30; and page 7, lines 17-20 of the specification), an offer validity period (FIG. 6, FIG. 11, page 6, line 30; page 7, lines 22-27; page 16, lines 5-6 of the specification) and an offer life period (page 7, line 29 through page 8, line 1). Also, one or more of the unspecified or variable offer parameters are assigned for customers on the basis of respective customer profile information (page 2, lines 26-28; page 5, lines 25-26; page 10, lines 22-23 of the specification).

The embodiments of the invention also provide that a plurality of the unspecified or variable offer parameters are assigned by different entities able to access different respective customer profile information (FIG. 2; page 2, lines 25-28; page 3, lines 17-28; page 6, lines 4-6 of the specification). Also, there is provided an incentive for the different entities to appropriately assign the unspecified or variable offer parameters (page 14, lines 3-10 of the specification). Moreover, one or more of the unspecified or variable offer parameters are assigned within a predetermined range of values (page 5, lines 16-20 of the specification). Furthermore, one or more of the unspecified or variable offer parameters are assigned in accordance with predetermined rules (page 13, lines 24-26 of the specification). Also, the predetermined rules vary for different respective customers (page 13, lines 24-26 of the specification). Additionally, the predetermined rules specify how to determine a respective customer's eligibility to redeem the offer (page 13, lines 24-26 of the specification).

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Moreover, the predetermined rules specify how to determine a respective customer's authorization to determine said one or more unspecified or variable parameters (page 13, lines 24-26 of the specification). Furthermore, the customer profile information can include demographic or behavioral information (page 10, lines 16-18 of the specification). Additionally, respective customers can decline to redeem the offer (page 19, line 9 of the specification). Also, the record of the offer is an electronic coupon (page 3, lines 30-31; page 5, lines 12-14 of the specification). Moreover, the record of the promotional offer is distributed online (page 3, line 32; page 10, line 3; page 12, lines 13-17; page 19, lines 23-25 of the specification). Also, the unspecified or variable parameter of offer discount information is determined for each customer such that the customer's utility for the promoted product of the product identifier information exceeds that of the customer's corresponding preferred brand product (FIG. 7; page 16, lines 9-16 of the specification). Furthermore, the unspecified or variable parameter of offer discount information is determined for each customer as the difference in price between the promoted product of the product identifier information and the customer's corresponding preferred brand product (FIG. 7; page 16, lines 9-16 of the specification). Additionally, the unspecified or variable parameter of offer validity period is determined for each customer as at least the period to the estimated time of the customer's next purchase (page 17, line 23 through page 18, line 2 of the specification). Moreover, the unspecified or variable parameters are defined when the offer is redeemed by respective customers or when requested by respective customers (page 5, lines 22-24 of the specification). Furthermore, said declinable value comprising any of a linear, polynomial, and exponential rate of decline in value (page 13, lines 9-10 of the specification).

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VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for review by the Board of Patents Appeals and Interferences are whether claims 1, 3-6, 15-32, and 42-48 are unpatentable under 35 U.S.C. §103(e) as being unpatentable over Lerat in view of DeLapa, and whether claims 7-14, and 33-41 are unpatentable under 35 U.S.C. §103(e) as being unpatentable over Lerat in view of DeLapa and Walker.

VII. ARGUMENT

A. The Prior Art References

1. The Lerat Reference

Lerat teaches a means to generate, distribute, exchange, verify and redeem coupons in a public network environment, such as the internet. This provides a safe way to create and distribute coupons from a manufacturer to one or more retailers, while at the same time giving the user all information corresponding to the coupon features.\

2. The DeLapa Reference

DeLapa teaches a computer-implemented method and apparatus for generating coupons to provide discounts for purchases and includes providing a computer-based kiosk at a retail establishment such as a grocery store. A user identification of a household is received at the kiosk. The kiosk outputs a series of targeted coupons which have been assigned to the individual household on the basis of at least one attribute of that household. Images of coupons may be

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formatted "on the fly" from parameters set forth in a coupon record. The system may further include an enhancement system which provides tools for enhancing the coupon offer data by designating particular offers as either a targeted coupon offer assigned to individual households as a function of purchases by that household or a mandatory coupon which is assigned to substantially all households. The kiosk may additionally print personalized messages by substituting for a keyword a value derived from an attribute of the identified household and outputting the graphic image of the personalized message.

3. The Walker Reference

Walker teaches a method enabling a frequent shopper reward system capable of tracking performance data of a plurality of members or account holders linked to a single frequent shopper account.

B. The Position in the Office Action

The Office Action indicates that Lerat teaches electronic coupons that are selected for downloading by users and that may include a parameter of value that is set to decline over time [abstract, ¶24]. The Office Action states that the collection of coupon parameters (product, type of discount, amount, redemption retailer, etc) is taken to provide the structure of the promotional offer. The Office Action suggests that Lerat teaches that users are identified and their history of shopping and coupon redemption is used to develop behavioral profiles [¶47, 80, 81]. The Office Action acknowledges that although Lerat teaches that coupons can be personalized for

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users (and hence, targeted) [¶74, 75], Lerat does not appear to select appropriate coupons on behalf of the user. The Office Action states that DeLapa et al teaches an electronic coupon system where user purchases are tracked and coupons are selected on behalf of the user's profile [abstract]. Accordingly, the Office Action concludes that it would have been obvious to one of ordinary skill at the time of the invention to have pre-selected coupons for the users and upon their logging into the system, presented (i.e. distributed the records of available targeted coupons for browsing and downloading) such targeted coupons to the users of Lerat. The Office Action reasons that this provides distribution of targeted offer records, acceptance of selected coupons and determination of a declining value upon acceptance by the user. According to the Office Action, the starting value is taken to provide a default value.

Regarding claim 4, the Office Action indicates that it would have been obvious to one of ordinary skill at the time of the invention to have reduced the value once a day (or other time period) until the offer expires; such provides a predetermined number of value changes. The Office Action reasons that, regarding claim 15, the behavioral information is taken to be met by the purchasing and redemption history of the user. The Office Action states that there is no requirement that the user redeem selected coupons and therefore the users are taken to be capable of declining redemption. Regarding claim 19, the Office Action indicates that the price sensitivity of the user will determine whether the user would prefer a discounted product or a higher priced, but otherwise preferable product; this claim is not taken to positively limit the method steps taken. The Office Action suggests that, regarding claim 20, the value can be virtually any amount, including the difference between a preferred brand price and the promoted

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products price. According to the analysis in the Office Action, further, the claims specify only a value, rather than particular steps which would determine such a value; the particular value of the offer is not taken to provide a patentable distinction. According to the Office Action, regarding claim 21, base claim 6 does not positively require a variable offer period and therefore forth details about such a period are likewise not positively required by the claims. The Office Action states that a customer's eligibility to redeem an offer is taken to be defined by the targeting of the offer-only certain user(s) can receive and redeem the targeted offers. The Office Action indicates that, regarding claim 48, Lerat does not appear to specify or limit the type of discount value decay and it would have been obvious to one of ordinary skill at the time of the invention to have provided any reasonable function including linear (x amount per day).

Regarding claim 7, the Office Action states that Walker teaches that user profiles determined different classes of users who can be given different incentive tiers [col 10, 14]. According to the Office Action, it would have been obvious to one of ordinary skill at the time of the invention to have provided different initial discount values for the coupons of Lerat based upon the user's profile/tier. Regarding claim 8, the Office Action indicates that Lerat teaches that different manufacturers can provide coupons; this provides targeted coupon offers by different entities able to access the user profiles. Regarding claim 9, the Office Action concludes that it is obvious that entities appropriately assign a discount value in order to provide an effective coupon campaign, rather than give products away at a loss.

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C. Appellants' Position

1. Independent Claims 1 and 22-27

Lerat in view of DeLapa fails to disclose, teach, or suggest the features of independent claims 1 and 22-27. Specifically, independent claims 1, 22, 23, 25, 26, and 27 recite, in part, "wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined." Likewise, independent claim 24 recites, in part, "wherein said promotional offer comprises a declinable value once said unspecified or variable parameters are defined." These features are not taught, suggested, or rendered obvious by Lerat in view of DeLapa contrary to the assertions in the Office Action.

In fact, page 2 of the Office Action states, "Lerat teaches electronic coupons that are selected for downloading by users and that may include a parameter of value that is set to decline over time [abstract, ¶24]." However, the abstract of Lerat is bereft of any language pertaining to a declinable value or its equivalent. Furthermore, while paragraphs [0024] and [0069] and Lerat generally refer to a declined value of the coupon, there is nothing in these paragraphs or anywhere else in Lerat that teaches that the record of the promotional offer (or the promotional offer itself) comprises a declinable value once the unspecified or variable parameters are defined, and as the Appellants' claimed invention clearly indicates, the unspecified or variable parameters are defined when the promotional offer is accepted or redeemed by respective customers. In Lerat, there is no indication that the coupons provide the declined value at the time of customer redemption or acceptance. Accordingly, Lerat does not teach all of the elements of the claimed invention. Likewise, DeLapa fails to teach these features either.

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In Appellants' invention, a customer can present his coupon to a store for redemption or determination of coupon parameters. When this occurs, the store determines the coupon parameters depending on the updated profile of the customer. This is distinct from Lerat and other random value coupons or time-decay coupons such as suggested in paragraph [0069] of Lerat (i.e., "time to live" coupon) as the value of the Appellant's offer is based on the updated profile of the customer and not merely on time or a random function. Accordingly, Lerat teaches away from the Appellants' claimed invention and irrespective of whether DeLapa is combined with Lerat, they still fail to teach, suggest, or render obvious all of the elements of the Appellants' claimed invention. Thus, the prima facie case of obvious has not been established because the prior art references, Lerat and DeLapa, fail to teach all of the elements of the Appellants' independent claims 1 and 22-27.

Additionally, Lerat does not describe having an unspecified or variable parameter. Rather, paragraph [0024] of Lerat simply refers to a coupon having characteristics that vary over time (or any other parameters). This is not the same thing as having unspecified or variable parameters as in the Appellants' claimed invention because the coupon's value in Lerat is what is variable; not its parameters, wherein the Appellants' unspecified or variable parameters are such that they are able to be personalized to individual customers as required (see Appellants' specification, page 2, lines 3-5). Furthermore, DeLapa is likewise silent as to teaching unspecified or variable parameters. Therefore, neither Lerat nor DeLapa teach unspecified or variable parameters in an analogous manner as the Appellants' claimed invention.

Insofar as references may be combined to teach a particular invention, and the proposed

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combination of Lerat and DeLapa with one another, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined.

For example, in In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), the court stated:

"[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." Furthermore, the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), stated, "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination."

In the present application, the reason given to support the proposed combination is improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for a part of another reference in order to try to meet, but failing nonetheless, the Appellants' novel claimed invention. Moreover, there is nothing in the prior art references themselves, namely Lerat and DeLapa, which suggests a motivation to combine elements from each reference in a manner consistent with the suggestion by the Office Action. Furthermore, the claimed invention meets the above-cited tests for obviousness by including embodiments such as "...said unspecified or variable parameters are defined when the promotional offer is accepted by respective customers, and wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined." As such, all of the claims of

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this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Board pass these claims to allowance and issue.

As declared by the Federal Circuit:

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Lerat fail to disclose all of the elements of the claims of the present invention, particularly, the unspecified or variable parameters being defined when the promotional offer is accepted by respective customers, and wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined, as discussed above, but also, if combined with DeLapa, fails to disclose these elements as well. The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Lerat, alone or in combination with DeLapa teaches a

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structure and method containing all of the limitations of the claimed invention. Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness." Therefore, independent claims 1 and 22-27 are patentable over Lerat in view of DeLapa. Therefore, in view of the foregoing, the Board is respectfully requested to withdraw the rejections to claims 1 and 22-27 and pass these claims to issue.

2. Dependent claims 3-6, 15-21, 28-32, and 42-48

(a) Dependent claims 3, 5-6, 19-21, 28-29, 31-32, and 45-47

With respect to claims 3, 5-6, 19-21, 28-29, 31-32, and 45-47, neither Lerat nor DeLapa teach unspecified or variable offer parameters. Rather, paragraph [0024] of Lerat simply refers to a coupon having characteristics that vary over time (or any other parameters). This is not the same thing as having unspecified or variable parameters as in the Appellants' claimed invention because the coupon's value in Lerat is what is variable; not its parameters, wherein the Appellants' unspecified or variable parameters are such that they are able to be personalized to individual customers as required (see Appellants' specification, page 2, lines 3-5). Furthermore, DeLapa is likewise silent as to teaching unspecified or variable parameters. Therefore, neither Lerat nor DeLapa teach unspecified or variable parameters in an analogous manner as the Appellants' claimed invention. Therefore, dependent claims 3, 5-6, 19-21, 28-29, 31-32, and 45-47 are patentable over Lerat in view of DeLapa. Therefore, in view of the foregoing, the Board is respectfully requested to withdraw the rejections to claims 3, 5-6, 19-21, 28-29, 31-32, and 45-

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47and pass these claims to issue.

(b) Dependent claims 4 and 30

With respect to claims 4 and 30, the assigned default values refer to the unspecified or variable parameters, which as explained above, neither Lerat nor DeLapa teach unspecified or variable parameters in an analogous manner as the Appellants' claimed invention. Page 3 of the Office Action concludes it would have been obvious to allow the assigned default values be changed a predetermined number of times. However, the Office Action offers no proof either in the cited prior art references or any other references or by the taking of Official Notice that such a feature is plausible with respect to Lerat in view of DeLapa. Absent such proof, the Appellants contend that such a rejection is improper. Therefore, dependent claims 4 and 30 are patentable over Lerat in view of DeLapa. Therefore, in view of the foregoing, the Board is respectfully requested to withdraw the rejections to claims 4 and 30 and pass these claims to issue.

(c) Dependent claim 15

With respect to claim 15, the Office Action rejects claim 15 under 35 USC §103(a) as unpatentable over Lerat in view of DeLapa. However, claim 15 depends from claim 7, which is rejected under 35 USC §103(a) as unpatentable over Lerat in view of DeLapa and Walker. Thus, as a practical matter, the rejection to claim 15 is improper because by rejecting the intervening base claim (claim 7) under the combination of Lerat, DeLapa, and Walker, the Office Action is, in essence, admitting that the features of claim 7 are not fully taught in Lerat and DeLapa. Thus,

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because claim 15 depends from claim 7, claim 15 incorporates all of the features of claim 7, and thus cannot be rejected based simply on Lerat in view of DeLapa. Accordingly, the Appellants contend that the rejection of claim 15 is improper. Therefore, dependent claim 15 is patentable over Lerat in view of DeLapa. Therefore, in view of the foregoing, the Board is respectfully requested to withdraw the rejections to claim 15 and pass this claim to issue.

(d) Dependent claims 16 and 42

With respect to claims 16 and 42, page 3 of the Office Action states that "there is no requirement that the user redeem selected coupons and therefore the users are taken to be capable of declining redemption." However, Appellants contend that the Examiner is unnecessarily broadening the scope of Lerat and DeLapa. While there may be no requirement that the user in either Lerat or DeLapa redeem the selected coupons, this does not mean that the users will decline the offer. Rather, this may mean that the users in Lerat and DeLapa are simply postponing their decision to redeem the coupons or that they have yet to have the opportunity to redeem the coupons, but will choose to do so in the future. Thus, the Appellants contend that the rejection to claims 16 and 42 is unnecessarily broad and accordingly is improper. Therefore, dependent claims 16 and 42 are patentable over Lerat in view of DeLapa. Therefore, in view of the foregoing, the Board is respectfully requested to withdraw the rejections to claims 16 and 42 and pass these claims to issue.

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(e) Dependent claims 17-18 and 42-43

With respect to claims 17-18 and 42-43, these claims depend on claims which recite “unspecified or variable parameters.” Therefore, neither Lerat nor DeLapa teach unspecified or variable parameters in an analogous manner as the Appellants’ claimed invention. Therefore, dependent claims 17-18 and 42-43 are patentable over Lerat in view of DeLapa. Therefore, in view of the foregoing, the Board is respectfully requested to withdraw the rejections to claims 17-18 and 42-43 and pass these claims to issue.

(f) Dependent claim 48

With respect to claim 48, pages 3-4 of the Office Action admits that Lerat fails to teach the features recited in claim 48 (i.e., that the decianble value comprising any of a linear, polynomial, and exponential rate of declien in value). Nonetheless, page 4 of the Office Action concludes it would have been obvious to provide any reasonable function. However, the Office Action offers no proof either in the cited prior art references or any other references or by the taking of Official Notice that such a feature is plausible with respect to Lerat in view of DeLapa. Absent such proof, the Appellants contend that such a rejection is improper. Therefore, dependent claim 48 is patentable over Lerat in view of DeLapa. Therefore, in view of the foregoing, the Board is respectfully requested to withdraw the rejections to claim 48 and pass this claim to issue.

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3. Dependent Claims 7-14 and 33-41

Insofar as references may be combined to teach a particular invention, and the proposed combination of Lerat, DeLapa, and Walker with one another, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined.

For example, in In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), the court stated: "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." Furthermore, the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), stated, "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination."

In the present application, the reason given to support the proposed combination is improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for a part of another reference in order to try to meet, but failing nonetheless, the Appellants' novel claimed invention. Moreover, there is nothing in the prior art references themselves, namely Lerat, DeLapa and Walker, which suggests a motivation to combine elements from each reference in a manner consistent with the suggestion by the Office Action. Furthermore, the claimed invention meets the above-cited tests for obviousness by including embodiments such as

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"unspecified or variable parameters." As such, all of the claims of this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Board pass these claims to allowance and issue.

As declared by the Federal Circuit:

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Lerat fail to disclose all of the elements of the claims of the present invention, particularly, the unspecified or variable parameters, as discussed above, but also, if combined with DeLapa and Walker, fails to disclose these elements as well. The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Lerat, alone, or in combination with DeLapa and Walker teaches a structure and method containing all of the limitations of the claimed invention.

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Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness." Accordingly, dependent claims 7-14 and 33-41 are patentable over Lerat in view of DeLapa and Walker. Therefore, in view of the foregoing, the Board is respectfully requested to withdraw the rejections to claims 7-14 and 33-41 and pass these claims to issue.

(a) Dependent claims 7-11, 14, 33-37, and 40

With respect to claims 7-11, 14, 33-37, and 40 neither Lerat nor DeLapa teach unspecified or variable offer parameters. Rather, paragraph [0024] of Lerat simply refers to a coupon having characteristics that vary over time (or any other parameters). This is not the same thing as having unspecified or variable parameters as in the Appellants' claimed invention because the coupon's value in Lerat is what is variable; not its parameters, wherein the Appellants' unspecified or variable parameters are such that they are able to be personalized to individual customers as required (see Appellants' specification, page 2, lines 3-5). Furthermore, DeLapa and Walker are each likewise silent as to teaching unspecified or variable parameters. Therefore, neither Lerat nor DeLapa nor Walker teaches unspecified or variable parameters in an analogous manner as the Appellants' claimed invention. Therefore, dependent claims 7-11, 14, 33-37, and 40 are patentable over Lerat in view of DeLapa and Walker. Therefore, in view of the foregoing, the Board is respectfully requested to withdraw the rejections to claims 7-11, 14, 33-37, and 40 and pass these claims to issue.

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(b) Dependent claims 12-13, 38-39, and 41

With respect to claims 12-13, 38-39, and 41, these claims depend on claims which recite “unspecified or variable parameters.” Therefore, neither Lerat nor DeLapa nor Walker teaches unspecified or variable parameters in an analogous manner as the Appellants’ claimed invention. Therefore, dependent claims 12-13 and 38-39 are patentable over Lerat in view of DeLapa and Walker. Therefore, in view of the foregoing, the Board is respectfully requested to withdraw the rejections to claims 12-13 and 38-39 and pass these claims to issue.

D. CONCLUSION

In conclusion, the prior art references of record, either alone or in combination with one another, fail to teach all essential elements of the Appellants’ claimed invention. In many instances, there appears to be an unnecessarily broad interpretation of the prior art references as indicated in the Office Action. As indicated above, regardless of how each of the prior art references are interpreted they still fail to teach the Appellants’ claimed invention as the prior art references either teach away from the Appellants’ claimed invention, are contrary to the Appellants’ claimed invention, or all together are bereft of any teaching whatsoever of the elements provided in the Appellants’ claimed invention.

Furthermore, each prior art reference cited by the Examiner is complete and functional in itself, so there is simply no motivation to use parts from or add or substitute parts to any reference to try and teach, but failing nonetheless, the Appellants’ claimed invention. Moreover, because the references take mutually exclusive paths and reach different solutions to a similar

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problem; i.e., coupon personalization, they essentially teach away from each other, and thus it would not be logical for one of ordinary skill in the art to combine them. However, even if the references were legally combinable, the references would not teach the Appellants' claimed invention because several claimed features are lacking in the prior art references.

In view of the foregoing, the Appellants submit that claims 1 and 3-48, all the claims presently pending in the application, are patently distinct from the prior art of record and are in condition for allowance. The Board is respectfully requested to cancel all of the rejections to the claims and to pass the application to issue. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,



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VIII. CLAIMS APPENDIX

1. (Previously Presented) A method of conducting a promotional offer over a computer

network, the method comprising:

defining the structure of said promotional offer having a plurality of associated parameters, one or more of which are unspecified or variable;

targeting one or more of a plurality of customers as recipients of the promotional offer;

and

distributing a record of the promotional offer to the customers over said computer network;

wherein one or more of the unspecified or variable parameters associated with the offer are individually assigned for one or more of the targeted customers to whom the record of the offer is distributed,

wherein said unspecified or variable parameters are defined when the promotional offer is accepted by respective customers, and

wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined.

2. (Canceled).

3. (Original) The method of claim 1, wherein one or more of the unspecified or variable offer parameters are assigned default values.

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4. (Original) The method of claim 3, wherein the assigned default values can be changed a predetermined number of times.
5. (Original) The method of claim 1, wherein the unspecified or variable parameters vary with time.
6. (Previously Presented) The method of claim 1, wherein the unspecified or variable offer parameters comprises at least one of an offer discount information, an offer validity period, and an offer life period.
7. (Original) The method of claim 1, wherein one or more of the unspecified or variable offer parameters are assigned for customers on the basis of respective customer profile information.
8. (Original) The method of claim 7, wherein a plurality of the unspecified or variable offer parameters are assigned by different entities able to access different respective customer profile information.
9. (Original) The method of claim 8, wherein there is provided an incentive for the different entities to appropriately assign the unspecified or variable offer parameters.

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10. (Original) The method of claim 8, wherein one or more of the unspecified or variable offer parameters are assigned within a predetermined range of values.
11. (Original) The method of claim 8, wherein one or more of the unspecified or variable offer parameters are assigned in accordance with predetermined rules.
12. (Previously Presented) The method of claim 11, wherein the predetermined rules vary for different respective customers.
13. (Original) The method of claim 11, wherein the predetermined rules specify how to determine a respective customer's eligibility to redeem the offer.
14. (Original) The method of claim 11, wherein the predetermined rules specify how to determine a respective customer's authorization to determine said one or more unspecified or variable parameters.
15. (Previously Presented) The method of claim 7, wherein the customer profile information can include demographic or behavioral information.
16. (Original) The method of claim 1, wherein respective customers can decline to redeem the offer.

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17. (Original) The method of claim 1, wherein the record of the offer is an electronic coupon.

18. (Original) The method of claim 17, wherein the record of the promotional offer is distributed online.

19. (Original) The method of claim 6, wherein the unspecified or variable parameter of offer discount information is determined for each customer such that the customer's utility for the promoted product of the product identifier information exceeds that of the customer's corresponding preferred brand product.

20. (Original) The method of claim 6, wherein the unspecified or variable parameter of offer discount information is determined for each customer as the difference in price between the promoted product of the product identifier information and the customer's corresponding preferred brand product.

21. (Original) The method of claim 6, wherein the unspecified or variable parameter of offer validity period is determined for each customer as at least the period to the estimated time of the customer's next purchase.

22. (Previously Presented) A method of conducting a promotional offer over a computer

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network, the method comprising:

defining the structure of said promotional offer to be made to a plurality of customers having a plurality of associated parameters, one or more of which are unspecified or variable,

wherein one or more of the unspecified or variable parameters associated are able to be individually assigned for one or more of the targeted customers to whom a record of the promotional offer is distributed over said computer network,

wherein said unspecified or variable parameters are defined when the promotional offer is redeemed by respective customers, and

wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined.

23. (Previously Presented) A method of conducting a promotional offer over a computer network, the method comprising:

distributing to one or more targeted customers a record of said promotional offer having a plurality of associated parameters; and

defining values of one or more of the associated parameters for respective targeted customers, when requested by the respective customers,

wherein said one or more of the parameters associated with the promotional offer are individually assigned to one or more of the targeted customers,

wherein said one or more of the parameters are defined when requested by respective customers, and

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wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined.

24. (Previously Presented) A method of conducting a promotional offer over a computer network, the method comprising:

targeting one or more of a plurality of customers as recipients of a said promotional offer having a plurality of associated parameters, one or more of which are unspecified or variable,

wherein one or more of the unspecified or variable parameters associated with the promotional offer are individually assigned for one or more of the targeted customers to whom a record of time offer is distributed over said computer network,

wherein said unspecified or variable parameters are defined when the promotional offer is redeemed by respective customers, and

wherein said promotional offer comprises a declinable value once said unspecified or variable parameters are defined.

25. (Previously Presented) A method of conducting a promotional offer over a computer network, the method comprising:

distributing to one or more targeted customers a record of a promotional offer having a plurality of associated parameters,

wherein one or more of the associated parameters associated with the promotional offer have been individually assigned to one or more of the targeted customers,

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wherein said parameters are defined when the promotional offer is redeemed by respective customers, and

wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined.

26. (Previously Presented) A computer program product having a computer readable medium having a computer program recorded therein conducting a promotional offer, said computer program comprising:

code adapted to defining the structure of said promotional offer having a plurality of associated parameters, one or more of which are unspecified or variable,

wherein said code targets one or more of a plurality of customers as recipients of the promotional offer,

wherein said code adapted to distributing a record of the promotional offer to the customers over said computer network,

wherein one or more of the unspecified or variable parameters associated with the promotional offer are individually assigned for one or more of the targeted customers to whom the record of the promotional offer is distributed,

wherein said unspecified or variable parameters are defined when the promotional offer is accepted by respective customers, and

wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined.

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27. (Previously Presented) Apparatus for conducting a promotional offer, the apparatus comprising:

code adapted to define the structure of said promotional offer having a plurality of associated parameters, one or more of which are unspecified or variable,

wherein said code targets one or more of a plurality of customers as recipients of the promotional offer,

wherein said code adapted to distributing a record of the promotional offer to the customers over said computer network,

wherein one or more of the unspecified or variable parameters associated with the promotional offer are individually assigned for one or more of the targeted customers to whom the record of the promotional offer is distributed,

wherein said unspecified or variable parameters are defined when the promotional offer is accepted by respective customers, and

wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined.

28. (Previously Presented) The apparatus of claim 27, wherein the unspecified or variable parameters are defined when the offer is redeemed by respective customers or when requested by respective customers.

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29. (Previously Presented) The apparatus of claim 27, wherein one or more of the unspecified or variable offer parameters are assigned default values.

30. (Original) The apparatus of claim 29, wherein the assigned default values can be changed a predetermined number of times.

31. (Original) The apparatus of claim 27, wherein the unspecified or variable parameters vary the time.

32. (Original) The apparatus of claim 27, wherein the unspecified or variable offer parameters can include one or more of offer discount information, after validity period, and offer life period.

33. (Original) The apparatus of claim 27, wherein one or more of the unspecified or variable offer parameters are assigned for customers on the basis of respective customer profile information.

34. (Original) The apparatus of claim 33, wherein a plurality of the unspecified or variable offer parameters are assigned by different entities able to access different respective customer profile information.

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35. (Previously Presented) The apparatus of claim 34, wherein an incentive is provided for the different entities to appropriately assign the unspecified or variable offer parameters.

36. (Original) The apparatus of claim 34, wherein one or more of the unspecified or variable offer parameters are assigned within a predetermined range of values.

37. (Original) The apparatus of claim 36, wherein one or more of the unspecified or variable offer parameters are assigned in accordance with predetermined rules.

38. (Original) The apparatus of claim 37, wherein the predetermined rules vary for different respective customers.

39. (Original) The apparatus of claim 37, wherein the predetermined rules specify how to determine a respective customer's eligibility to redeem the offer.

40. (Original) The apparatus of claim 37, wherein the predetermined rules specify how to determine a respective customer's authorization to determine said one or more unspecified or variable parameters.

41. (Previously Presented) The apparatus of claim 33, wherein the customer profile information can include demographic or behavioral information.

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42. (Original) The apparatus of claim 26, wherein respective customers can decline to redeem the offer.

43. (Original) The apparatus of claim 26, wherein the record of the offer is an electronic coupon.

44. (Original) The apparatus of claim 43, wherein the record of the promotional offer is distributed online.

45. (Original) The apparatus of claim 32, wherein the unspecified or variable parameter of offer discount information is determined for each customer such that the customer's utility for the promoted product of the product identifier information exceeds that of the customer's corresponding preferred brand product.

46. (Original) The apparatus of claim 32, wherein the unspecified or variable parameter of offer discount information is determined for each customer as the difference in price between the promoted product of the product identifier information and the customer's corresponding preferred brand product.

47. (Original) The apparatus of claim 32, wherein the unspecified or variable parameter of

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offer validity period is determined for each customer as at least the period to the estimated time of the customer's next purchase.

48. (Original) The method of claim 1, wherein said declinable value comprising any of a linear, polynomial, and exponential rate of decline in value.

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IX. EVIDENCE APPENDIX

There is no other evidence known to Appellants, Appellants' legal representative or Assignee which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

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X. RELATED PROCEEDINGS APPENDIX

There are no other related proceedings known to Appellants, Appellants' legal representative or Assignee which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.